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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,432	08/01/2001	John M. Cuckler	10557/247605	6380
30559 7590 11/10/2008 CHIEF PATENT COUNSEL SMITH & NEPHEW, INC. 1450 BROOKS ROAD MEMPHIS, TN 38116				
EXAMINER				
WILLSE, DAVID H				
ART UNIT		PAPER NUMBER		
3738				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/920,432

Applicant(s)

CUCKLER ET AL.

Examiner

David H. Willse

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10-38,41,42,47,49,51,53,56,57,59,61,63,66 and 77-88 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10-38,41,42,47,49,51,53,56,57,59,61,63,66 and 77-88 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15-17 and 77-82 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 15-17, lines 1-2 of each, "the flange member" lacks a proper antecedent basis. In claim 77, line 11, "distal" should be replaced by --proximal-- (in view of the drawings and line 4 of claim 77); lines 15-16 of claim 77 lack proper syntax. In claim 80, last line, "the curved flange *member*" (emphasis added) lacks a proper antecedent basis. In claim 82, "the acetabular cup" lacks a proper antecedent basis.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 56, 57, 66, and 88 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Giacometti Ceroni, EP 0 605 368 A1, which discloses a cup-shaped acetabular device **1**; a superior flange (the uppermost element **20** pictured in Figure 1); a posterior flange (one of the other elements **20**, depending on how the device **1** is oriented within a patient: Figure 7); an inferior flange **40**; a containment lip defined between recesses **10** for receiving the superior and posterior flanges (column 2, line 49 et seq.); and a liner (column 2, lines 44-48) *capable* of being cemented in the device **1**, whether or not such was the intent.

Claims 14-34, 59, 61, 63, 84, and 85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giacometti Ceroni, EP 0 605 368 A1. Regarding claim 14 and others, one or more of flanges **20** and **40** being curved and having a lower surface and an edge that falls in a flange plane forming an angle with a rim plane would have been obvious to the ordinary practitioner in order to provide anchorage to “sound regions of the pelvis” (abstract, line 12) so as to circumvent “damaged” regions “affected by bone lysis” (column 1, lines 40-43), with the scope of the Giacometti Ceroni invention encompassing various shapes, numbers, and arrangements of “small plates, fins or tongues and the like” (column 3, lines 27-31). Regarding claims 15 and 32, with the uppermost T-shaped element **20** (Figure 1) affixed to the cup body **1**, the distally extending concave surface defined by the “lower” portion of the T-shape and the two adjacent raised portions of the cup body **1** subtends an angle of at least about 45° (Figure 5), and the elongated “upper” portion of the T-shape likewise subtends an angle of about 45° or more, or such would have been obvious in order to provide attachment to larger regions of bone.

Regarding claim 16, broader flange members **20** spanning 90° or more would have been obvious for severely damaged or diseased bone in order to enhance securement and to augment or reinforce the bone; with two flange elements **20** engaging adjacent recesses **10**, a distally extending concave surface subtending an angle of at least 90° is created (Figures 1 and 5). Regarding claim 21 and others, bone screws extending through openings in an acetabular cup body were quite common in the art at the time of the present invention and would have been an obvious supplement in order to fix the cup to relatively healthy portions of the acetabulum for improved stability. Regarding claim 24, a cup wall thickness of about 2 mm would have been within the realm of obvious variants in order to optimize the weight and strength characteristics of selected materials (column 3, lines 40-43) for a diversity of patients. Regarding claim 26 and others, annular bosses were likewise common in the art at the time of the present invention and would have been obvious in order to reinforce the openings and/or to receive the heads of bone screws and/or to create a space for bone cement. Regarding claim 31, a slot would have been obvious in order to provide for selective positioning and angling of a bone screw or in order to accommodate some of the affixation means listed at column 3, lines 4-7.

Claims 14, 17-23, 25, 31, 33, 80, 81, 84, and 85 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Castera, FR 2 710 522 A1: drawings; English abstract. Figures 3 and 7 show an acetabular cup body **1** and a curved flange portion **22**, with a portion **21** of the concave surface of the cup body extending distally to a greater extent adjacent the flange portion **22**. Regarding claim 80, the buttress **21** is integrally mounted on the distal concave surface of the cup body **1** and at a lower surface of the flange portion **22** and is outwardly and

circumferentially curved (along the rim or shoulder **5**) to generally follow the curved flange portion **22**.

Claims 15, 24, 26-30, 32, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castera, FR 2 710 522 A1. Regarding claims 15 and 32, elements **21** and **22** extending circumferentially around the cup body **1** by as much as 45° would have been obvious in order to provide a greater number of screw holes (which would have been obvious, if not inherent) for directly affixing the flange portion **22** to the hip bone in a more secure manner and/or to provide greater selectivity as to the number and location of bone screws passing through and anchoring the flange portion **22** (Figure 7). The further limitations of other claims would have been obvious for reasons similar to those presented above.

Claims 14, 17, 18, 23, 35-38, 41, 42, 56, 59, 61, 63, 66, 84-86, and 88 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Fischer et al., FR 2 710 836 A1. Regarding claim 14 and others, the drawings illustrate an acetabular cup body **3** and curved flange portions **8** (Figures 1, 3, and 5), with portions of the concave surface of the cup body wall extending distally to a greater extent adjacent the flange portions **8** by virtue of the chamfering or beveling of the metal cup toward the curved leg **5** (Figures 1-3) and by virtue of the flange **8** thicknesses projecting from a cup rim. Regarding claim 56, the liner **4** is *capable* of being cemented within the cup-shaped device **3**, whether or not such was the intent.

Claims 1, 3-8, 10-12, 15, 16, 19-22, 24-34, 47, 49, 51, 53, 57, 82, and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer et al., FR 2 710 836 A1. Regarding claim 1 and others, the cup body **3** having a plurality of bone screw openings would have been obvious to the ordinary practitioner in order to better stabilize the prosthesis relative to the hip

bone. Other claimed features would have been obvious for reasons similar to those set forth above.

Claims 1, 3-8, 10-38, 41, 42, 47, 49, 51, 53, 56, 57, 59, 61, 63, 66, 77-79, and 82-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capello, US 5,702,477, which includes a cup body **20**, a liner **18**, an annular rim **28**, a cement mantle **92**, flanges **42**, **44**, and **50**, and an extension of the concave surface at supplemental support web **60**. A cup wall thickness within the specified range and openings reinforced as claimed (e.g., claim 13) and other features would have been obvious for reasons similar to those presented above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse, whose telephone number is 571-272-4762 and who is generally available Monday, Tuesday, and Thursday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

**/David H. Willse/
Primary Examiner
Art Unit 3738**